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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of: Andrew S. Kanter  
Serial No.: 09/909,644  
Filed: July 20, 2001  
For: "INTERNET ADVERTISING"  
Docket No.: 0010-2

Group Art Unit: 2162  
Examiner: N/A

Morristown, N.J. 07960  
September 18, 2003

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450  
ATTENTION: Group Director, Group 2162

Sir:

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SEP 30 2003  
**GROUP 3600**

**PETITION TO MAKE SPECIAL FOR NEW APPLICATION**  
**UNDER M.P.E.P. § 708.02 (VIII)**

Applicant hereby petitions to make special this new application. The application has not yet been examined by the United States Patent and Trademark Office (the "Office").

Applicant submits that all of the claims in this case are directed to a single invention. If the Office determines that all claims presented are not obviously directed to a single invention, then applicant will make an election, without traverse, as a prerequisite to the grant of special status.

A pre-examination search of the subject matter encompassed by the above-identified application has been made by a professional searcher. The pre-examination search was conducted in the United States Patent and Trademark Office. The field of search covered Class 705, subclasses 1, 14, 26 and 27; Class 707, subclasses 501 and 513; and Class 709, subclasses 201, 202, 203 and 219. A search was also conducted on the USPTO system WEST and on Dialogue to determine foreign counterparts and patents assigned to Lucent Technologies, AT&T, Sony, Juno On Line Services, Double Click, Sony and other key actors. Copies of the references developed by the pre-examination search were submitted with applicant's Information Disclosure Statement dated May

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23, 2002. A statement pertaining to the pre-examination search listing the references deemed most closely related to the subject matter encompassed by the claims is submitted herewith.

Applicant also submits herewith a detailed discussion of the references, which discussion particularly points out how the claimed subject matter is distinguishable over the references.

Enclosed herewith is a check in the amount of \$130, to cover the fee for this Petition. In the event that any additional fee is deemed to be required by 37 C.F.R. 1.17(h), it is requested that applicants be contacted at (973) 644-0008 and provided an opportunity to effect payment thereof.

A duplicate of this petition is attached.

Respectfully submitted,  
Andrew S. Kanter

By   
Ernest D. Buff  
(His Attorney)  
Reg. No. 25,833  
(973) 644-0008



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of:	Andrew S. Kanter	Group Art Unit:	2162
Serial No.:	09/909,644	Examiner:	N/A
Filed:	July 20, 2001		
For:	<b>"INTERNET ADVERTISING"</b>		
Matter No.:	0010-2		

Morristown, N.J. 07960  
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P.O. Box 1450  
Alexandria, VA 22313-1450

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Sir:

**STATEMENT PERTAINING TO PRE-EXAMINATION SEARCH**  
**IN ACCORDANCE WITH MPEP § 708.02(VIII)**

In accordance with MPEP § 708.02 (VIII), applicants, by and through their attorney, hereby submit that a pre-examination search was made for the above-identified application. The search was conducted by applicants' agents at the United States Patent and Trademark Office. The field of search covered Class 705, subclasses 1, 14, 26 and 27; Class 707, subclasses 501 and 513; and Class 709, subclasses 201, 202, 203 and 219. A search was also conducted on the USPTO system WEST and on Dialogue to determine foreign counterparts and patents assigned to Lucent Technologies, AT&T, Sony, Juno On Line Services, Double Click, Sony and other key actors. Copies of the references developed by the pre-examination search were submitted with applicant's Information Disclosure Statement dated May 23, 2002.

The search identified the following U. S. Patents:

**UNITED STATES PATENTS**

Ref. #	Patent No.	Inventor(s)
✓ 1	5,105,184	Pirani et al.
✓ 2	5,572,643	Judson
✓ 3	5,737,619	Judson
✓ 4	5,781,894	Petrecca et al.
✓ 5	5,848,397	Marsh et al.
✓ 6	5,933,811	Angles et al.
✓ 7	5,937,392	Alberts
✓ 8	5,946,664	Ebisawa
✓ 9	5,948,061	Merriman et al.
✓ 10	5,999,912	Wodarz et al.
✓ 11	6,009,409	Adler et al.
✓ 12	6,009,410	LeMole et al.
✓ 13	6,026,368	Brown et al.
✓ 14	6,026,369	Capek
✓ 15	6,036,601	Heckel

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The search identified the following web sites:

16. "AOL, Anytime, Anywhere". Available at <http://www.aol.com>, June 23, 2000.
17. "Push PointCast". Available at <http://www.webopedia.com>, April 7, 2000.
18. "Why Search, EntryPoint Delivers!". Available at <http://www.entrypoint.com>, April 7, 2000.

The search identified the following press release:

19. Unicast, "Unicast Marks One-Year Anniversary of Superstitial™ Ad Format With the Release of New Version, 3.0", PR Newswire, April 26, 2000, 4 pages.

Each of the foregoing references has been identified and discussed in the Detailed  
Discussion of the References Submitted in Compliance with MPEP § 708.02(VIII).

Respectfully submitted,  
Andrew S. Kanter



By \_\_\_\_\_  
Ernest D. Buff  
(His Attorney)  
Reg. No. 25,833  
(973) 644-0008

0010-2-PMSS1



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

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**DETAILED DISCUSSION OF THE REFERENCES SUBMITTED**  
**WITH THE INFORMATION DISCLOSURE STATEMENT**  
**IN COMPLIANCE WITH MPEP § 708.02 (VIII)**

In accordance with MPEP § 708.02(VIII), applicants hereby submit a detailed discussion of references applicable to the above-identified application. Each of these references was listed in the Information Disclosure Statement filed with the United States Patent and Trademark Office on May 23, 2002, in connection with the above-identified application.

**1. U. S. Patent No. 5,105,184 to Pirani, et al.**

United States Patent No. 5,105,184 to Pirani, et al (the '184 patent) discloses a method for displaying and integrating commercial advertisements with computer software. Commercial advertisements of small, medium or full-page size are integrated with different screen types. This results in a change from screen before the advertisements to screen after the advertisements. Also integrated is the sequence of different size screens. Integration of these advertisements in the first screen, second screen, third screen, menu screen, or last screen may be full, partial or non-extant. A commercial advertisement of an appropriate size may be additionally integrated with different

screens at different locations on the screen. Furthermore, a directory advertisement is accessible by menu or other input devices to display various commercial advertisements.

There is no disclosure or suggestion in the '184 patent concerning the method called for by present claims 1-20. In contrast to the teaching of the '184 patent the method of applicant's claims 1-20 comprises in combination a plurality of key features. That is to say, applicant's claims 1-20 provide a method for advertising to a user accessing the Internet, wherein a) an advertisement window opens and closes on the user's monitor within a preselected time frame, b) the user is not able to modify the advertisement window, and c) the user can claim compensation for receiving the advertisements. This combination of key features is not disclosed or suggested by the '184 patent.

For these reasons, there is ample basis for patentably distinguishing present claims 1-20 from the '184 patent disclosure.

## 2. U. S. Patent No. 5,572,643 to Judson

United States Patent No. 5,572,643 to Judson (the '643 patent) discloses a method for browsing the Worldwide Web of the Internet using an HTML-compliant client supporting a graphical user interface and a browser. The method begins as a web page that is being displayed on the graphical user interface. The web page has at least one link to a hypertext document, which is preferably located at a remote server. When the user clicks on the link, the link is activated by the browser to thereby request downloading of the hypertext document from the remote server to the graphical user interface of the client. While the client waits for a reply and/or as the hypertext document is being downloaded, the browser displays one or more different types of informational messages to the user. Such messages include, for example, advertisements, notices, messages, copyright information and the like.

There is no disclosure or suggestion in the '643 patent concerning the method called for by present claims 1-20. In contrast to the teaching of the '643 patent, the method of applicant's claims

1-20 collectively comprises a plurality of key features. That is to say, applicant's claims 1-20 provide a method for advertising to a user accessing the Internet, wherein a) an advertisement window opens and closes on the user's monitor within a preselected time frame, b) the user is not able to modify the advertisement window, and c) the user can claim compensation for receiving the advertisements. This key feature combination is in no way suggested by the '643 patent teaching.

In light of these structural and procedural distinctions, present claims 1-20 patentably define over the '643 patent disclosure.

### 3. U. S. Patent No. 5,737,619 to Judson

United States Patent No. 5,737,619 to Judson (the '619 patent) discloses a computer program product and method of browsing the World Wide Web of the Internet. Browsing is accomplished using a client machine (e.g., a personal computer) supporting a graphical user interface and an Internet browser. Information objects are locally stored, retrieved and outputted to reduce the waiting time normally associated with the download of hypertext documents having high-resolution graphics. In one embodiment, the Judson '619 method begins as a web page is being displayed on the graphical user interface. The web page has at least one link to a hypertext document preferably located at a remote server. When the user clicks on the link, the link is activated by the browser. Activation of the link thereby requests downloading of the hypertext document from the remote server to the graphical user interface of the client. While the client waits for a reply and/or as the hypertext document is being downloaded, the browser displays a previously cached information object.

There is no disclosure or suggestion in the '619 patent concerning the method called for by present claims 1-20. In contrast to the teaching of the '619 patent, the method of applicant's claims 1-20 comprises a combined plurality of key features. That is to say, applicant's claims 1-20 provide a method for advertising to a user accessing the Internet wherein a) an advertisement window opens



and closes on the user's monitor within a preselected time frame, b) the user is not able to modify the advertisement window, and c) the user can claim compensation for receiving the advertisements. This key feature combination is not disclosed or suggested by the '619 patent.

In view of these structural and procedural distinctions, the subject matter of present claims 1-20 and the '619 patent disclosure are patentably distinct.

#### 4. U. S. Patent No. 5,781,894 to Petrecca, et al.

US Patent 5,781,894 to Petrecca , et al., hereinafter the '894 patent, discloses an advertising system appointed for use with personal computers. The system enables sponsors to present advertisements or commercials to a user during periods of waiting-time, which are inherent in normal computer use. A segment of a software product contains one or more sponsors' audio, visual, or multi-modality messages. The advertising system chooses one of these messages and presents it to the user of the computer during the times that the user is not normally able to use the computer keyboard because information is being loaded up or sent out. Such times occur during the start-up of a program or during the sending of information from the computer to a peripheral device such as a printer, modem, or fax. The advertisement, or sequence of advertisements, may be chosen based upon the amount of time which the computer will need to achieve a task before being ready for new input from the user. A user of the system is allowed to choose to activate an advertising system in return for receiving some type of compensation.

The '894 patent discloses a method and system for advertising on personal computers. It comprises, among other components, a message presentation controller means for determining whether a computer will present the advertising message to a user. The means for determining whether the computer will present the advertising message comprises a unique identifier number associated with one or more software programs. In addition, the identifier number is associated with

two activation numbers, one of which activates two software programs and the advertising message, and the other of which activates only the software programs.

The '894 patent does not provide a method of advertising to a user accessing the internet wherein a) an advertisement window opens and closes on the user's monitor within a preselected time frame, b) the user is not able to modify the advertisement window, and c) the user can claim compensation for receiving the advertisements. On the other hand, present claims 1-20 do not utilize a message presentation controller means for determining if a computer will present the advertising message to a user. Moreover, the subject matter of applicant's claims do not involve a message presentation controller means comprising an identifier number that is (i) associated with one or more software programs, and (ii) associated with two activation numbers, one of which activates two software programs and an advertising message, and the other of which activates only the software programs.

These structural and procedural differences patentably distinguish the applicant's claims 1-20 from the '894 patent disclosure.

5. U. S. Patent No. 5,848,397 to Marsh, et al.

United States Patent No. 5,848,397 to Marsh, et al. (the '397 patent) discloses a method and apparatus for scheduling the presentation of a continuously changing display to computer users. Such method and apparatus are particularly well suited for use in an advertisement-supported e-mail service. An advertisement display scheduler resident on a user's computer receives advertisements from a server system over a network. Upon receipt, the advertisement display scheduler determines the priority of the advertisement and assigns it to one of a plurality of prioritized advertisement queues. Each queue is sorted according to predetermined scheduling criteria so that advertisements deemed "more important" are presented to a user first. The advertisement display scheduler logs

statistical information relating to the presentation of advertisements for use in updating the scheduling criteria, and makes such statistical information available to the server system.

There is no disclosure or suggestion in the '397 patent concerning the method called for by present claims 1-20. In contrast to the teaching of the '397 patent the method of applicant's claims 1-20 comprises in combination a plurality of key features. That is to say, applicant's claims 1-20 provide a method for advertising to a user accessing the Internet wherein a) an advertisement window opens and closes on the user's monitor within a preselected time frame, b) the user is not able to modify the advertisement window, and c) the user can claim compensation for receiving the advertisements. No method containing the combined presence of this key feature combination is disclosed or suggested by the '397 patent.

The presence of these structural and procedural distinctions provides ample basis for patentably differentiating applicant's claims 1-20 from the '397 patent disclosure.

6. U. S. Patent No. 5,933,811 to Angles, et al.

US Patent 5,933,811 to Angles, et al., hereinafter the '811 patent, discloses a system and method for delivering customized electronic advertisements in an interactive communication system. The customized advertisements are selected based on consumer profiles and are then integrated with offerings maintained by different content providers. The preferred interactive communication system interconnects multiple consumer computers, multiple content provider computers and multiple Internet provider computers with an advertisement provider computer. Whenever a consumer directs one of the consumer computers to access an offering existing in one of the content provider computers, an advertising request is sent to the advertisement provider computer. Upon receiving the advertising request, the advertising provider computer generates a custom advertisement based on the consumer's profile. The custom advertisement is then combined with the offering from the content provider computer and displayed to the consumer. The advertisement

provider computer also credits a consumer account, a content provider account and an Internet provider account each time a consumer views a custom advertisement. Furthermore, the advertisement provider computer tracks consumer responses to the customized advertisements.

The '811 patent discloses a system and method for delivering customized advertisements within interactive communication systems. The '811 patent does credit a consumer account; but it does not provide a method of advertising to a user accessing the Internet wherein (i) an advertisement window opens and closes on the user's monitor within a preselected time frame, and (ii) the user is not able to modify the advertisement window. On the other hand, present claims 1-20 call for an advertising method directed to a user accessing the Internet, wherein a) an advertisement window opens and closes on the user's monitor within a preselected time frame, b) the user is not able to modify the advertisement window, and c) the user can claim compensation for receiving the advertisements. This combination of features is not contained by the '811 patent disclosure.

Based on these structural and procedural distinctions, the present claims 1-20 patentably differentiate the disclosure of the '811 patent.

#### 7. U. S. Patent No.5,937,392 to Alberts

US Patent 5,937,392 to Alberts, hereinafter the '392 patent, discloses an Internet advertising system having a database, a controller, and an ad server operating as part of a web server. The database has advertising campaign information, including identification information and frequency information for how often the ad is to be served. The ad server uses the campaign information from the database to control the relative ratios of serving ads, the distribution of ads throughout the day, and any triggering mechanisms for controlling what ads are served.

The '392 patent discloses an advertising system that comprises, among other components, a number of counters. It uses the counters when determining which of the ads to serve. The '392 does not provide an advertising method targeted to a user accessing the Internet, wherein (i) an

advertisement window opens and closes on the user's monitor within a preselected time frame, and (ii) the user is unable to modify the advertisement window. By way of contrast, present claims 1-20 do not provide a plurality of counters and a mechanism for using them when determining which of the ads to serve. In further contrast, present claims 1-20 provide an advertising method directed toward a user accessing the Internet, wherein a) an advertisement window opens and closes on the user's monitor within a preselected time frame, b) the user is not able to modify the advertisement window, and c) the user can claim compensation for receiving the advertisements. This unique combination of features is not disclosed or suggested by the '392 patent.

In light of these structural and procedural distinctions, the '392 patent disclosure presents no obstacle to patentability of present claims 1-20.

#### 8. U. S. Patent No. 5,946,664 to Ebisawa

US Patent 5,946,664 to Ebisawa, hereinafter the '664 patent, discloses a system which is operable to update advertisements that are displayed when a game program is executed. The system stores a game program in a memory, receives updated advertising data that relates to at least one advertisement, stores the received advertising data in the memory, executes the game program stored in the memory, and outputs during the execution of the game program display data which corresponds to the stored advertisement data in accordance with the game program code. The receiving (i.e., downloading) of advertising data is accomplished at predetermined times of operation, for example, on each new day the game program is executed or each time the game program is executed. Instead of downloading new advertisements, plural advertisements may be prestored with the game program. Only advertisement selection codes are downloaded to update the advertisements that are displayed when the game program is executed.

There is no disclosure or suggestion in the '664 patent concerning the method called for by present claims 1-20. Unlike the teaching of the '664 patent the method of applicant's claims 1-20

comprises in combination a plurality of key features. That is to say, applicant's claims 1-20 provide a method for advertising to a user accessing the Internet wherein a) an advertisement window opens and closes on the user's monitor within a preselected time frame, b) the user is not able to modify the advertisement window, and c) the user can claim compensation for receiving the advertisements. Such a key feature combination is not contained within the '664 patent teaching.

For these reasons, there exists ample basis upon which to predicate patentability of present claims 1-20 over the '664 patent disclosure.

9. U. S. Patent No. 5,948,061 to Merriman, et al.

US Patent 5,948,061 to Merriman et al., hereinafter the '061 patent, discloses methods and apparatuses for targeting the delivery of advertisements over a network such as the Internet. Statistics are compiled on individual users and networks and the use of the advertisements. These statistics are tracked to permit targeting of the advertisements of individual users. In response to requests from affiliated sites, an advertising server transmits to people accessing the page of a site an appropriate one of the advertisements based upon profiling of users and networks.

The '061 patent discloses a network comprising, among other components, an advertiser node having an advertiser web site including advertising content. The advertiser node is responsive to a request to provide the advertising content.

The '061 patent does not provide a method for advertising to a user accessing the internet, wherein (i) an advertisement window opens and closes on the user's monitor within a preselected time frame and (ii) the user is not able to modify the advertisement window. By way of contrast, present claims 1-20 provide a method for advertising to a user accessing the internet, wherein a) an advertisement window opens and closes on the user's monitor within a preselected time frame, b) the user is not able to modify the advertisement window, and c) the user can claim compensation for receiving the advertisements.

These structural and procedural differences provide ample basis for patentably distinguishing present claims 1-20 from the '061 patent disclosure.

10. U. S. Patent No. 5,999,912 to Wodarz, et al.

US Patent 5,999,912 to Wodarz, et al., hereinafter the '912 patent, discloses dynamic advertising scheduling, display, and tracking for the World Wide Web. The invention includes at least one template web page that has conventional HTML codes defining the format and content of the web page. Special "ad tags" are used to indicate the characteristics of an ad that can be displayed on a web page at the position of the ad tag. A request to view a page is sent to a server-resident parser. The parser accesses the template for the requested page, parses the conventional HTML codes, and provides such codes to the user. In addition, the parser "expands" each ad tag to standard HTML code that defines the characteristics of an ad. During expansion of ad tags, the parser determines from each ad tag the type of ad that can be inserted at the page position of the ad tag; a bin identifier defining which ads can be associated with the ad tag; a page identifier of the page associated with the ad tag; and various optional flags and codes. The parser generates a list of valid ads by searching through a conventional database, selects one that fulfills all the parameters of the ad tag, and generates HTML code linking a particular ad to the ad tag. That HTML code is then sent to the user. The parser program can also apply scheduling criteria to select ads from the generated list of eligible candidates.

The '912 patent discloses a method comprising, among other steps, the step of determining whether the coded information includes ad tags. Each ad tag defines an associated location on the web page for an advertisement and characteristics of advertisements that may be displayed at that location. The '912 patent does not provide a method of advertising to a user accessing the Internet wherein (i) an advertisement window opens and closes on the user's monitor within a preselected time frame, and (ii) the user is not able to modify the advertisement window.

By way of contrast, present claims 1-20 provide a method of advertising to a user accessing the Internet wherein a) an advertisement window opens and closes on the user's monitor within a preselected time frame, b) the user is unable to modify the advertisement window, and c) the user can claim compensation for receiving the advertisements. The combined use of these key features is not disclosed or suggested by the '912 patent teaching.

In light of these structural and procedural differences, present claims 1-20 and the '912 disclosure are patentably distinct.

11. U. S. Patent No. 6,009,409 to Adler, et al.

US Patent 6,009,409 to Adler, et al., hereinafter the '409 patent, discloses a system and method for scheduling and controlling delivery of advertising in a communications network. Also disclosed is the combination of a communications network and remote computer program employing the system or the method. The system includes: (1) a time allocation controller that allocates time available in a particular advertising region in a display device of a remote computer between at least two advertisements as a function of one of a desired user frequency, a desired time frequency, or a desired geometry, for each of the at least two advertisements, and (2) data communication controller, coupled to the time allocation controller, that delivers the advertisements to the remote computer for display in the advertising region according to the allocating of the time.

The '409 patent discloses a system for scheduling and controlling delivery of advertising in a communications network comprising, among other steps, delivering at least two advertisements to the remote computer for display in the advertising region according to an allocation of time and space. The '409 patent does not disclose a method of advertising to a user accessing the internet wherein an advertisement window opens and closes on the user's monitor within a preselected time frame and where the user is unable to modify the advertisement window. On the other hand, the



present claims 1-20 are not operative to deliver at least two advertisements to a remote computer for display in an advertising region according to an allocation of time and space. Rather, the subject systems provide a method of advertising to a user accessing the Internet comprising in combination a plurality of key features: a) an advertisement window opens and closes on the user's monitor within a preselected time frame, b) the user is not able to modify the advertisement window, and c) the user can claim compensation for receiving the advertisements. The key feature combination required by applicant's claims 1-20 is not disclosed or suggested by the '409 patent teaching.

In light of these structural and procedural distinctions, the subject matter of applicant's claims 1-20 patentably differentiates the '409 patent disclosure.

12. U.S. Patent No. 6,009,410 to LeMole, et al.

United States Patent No. 6,009,410 to LeMole, et al., hereinafter the '410 patent, discloses a customized advertising repository server connected on the World Wide Web (WWW). The server can be accessed by a registered user through his or her browser either by clicking on an icon, or by inputting the specific URL address of the particular server, which stores that user's advertising repository. When the user accesses his or her customized ad repository through the browser, a composite advertising page is dynamically configured by the Customized Advertising Repository (CAR) server for that particular user based on that user's previously provided user profile. Furthermore, at least a portion of that composite advertising page can be dynamically configured on a context dependent basis determined from the particular Web site or sites that the user has accessed prior to accessing the CAR. The dynamically configured composite page or pages of advertising provided to the user may contain plural static images, streaming banners, 3-D images, animation, video and/or audio clips, using any of the technologies available on the Web for presenting textual and/or visual information. Such a composite page or pages is configured from a database which stores such images, banners, animation, etc., from plural advertisers. The customized page is created

by selecting from among a storehouse of plural different subscribing advertisers and their associated banner ads, images, etc., those particular images, etc. that will be elements of the customized page based on the user's specific areas of interest as determined from the profile, and/or the context dependency. From such dynamically configured composite page or pages, the user then clicks on a particular image, video window, banner, etc., to retrieve, through a hyperlink, further information directly from the selected advertiser's own Web site or mirror Web site.

There is no disclosure or suggestion in the '410 patent concerning the method called for by present claims 1-20. In contrast to the teaching of the '410 patent the method of applicant's claims 1-20 collectively comprises a plurality of key features. That is to say, applicant's claims 1-20 provide a method for advertising to a user accessing the Internet wherein a) an advertisement window opens and closes on the user's monitor within a preselected time frame, b) the user is not able to modify the advertisement window, and c) the user can claim compensation for receiving the advertisements. In combination, these key features are not disclosed or suggested by the '410 patent teaching.

In view of these structural and procedural distinctions, the subject matter of present claims 1-20 and the '410 patent disclosure are patentably distinct.

13. U. S. Patent No. 6,026,368 to Brown, et al.

United States Patent No. 6,026,368 to Brown, et al., hereinafter the '368 patent, discloses prioritized queues of advertising and content data generated by a queue builder and sent to an on-line queue manager. A computer mediated communications network provides content and subscriber data to the queue builder and receives content segment play lists from the on-line queue manager. An exposure accounting module calculates and stores information about the number of exposures of targeted material received by subscribers and generates billing information. An

information warehouse manager is employed to receive data from advertisers' databases and third party sources as well as from the computer mediated communications network.

There is no disclosure or suggestion in the '368 patent concerning the method called for by present claims 1-20. Unlike the teaching of the '368 patent the method of applicant's claims 1-20 comprises in combination a plurality of key features. That is to say, applicant's claims 1-20 provide a method for advertising to a user accessing the Internet wherein a) an advertisement window opens and closes on the user's monitor within a preselected time frame, b) the user is not able to modify the advertisement window, and c) the user can claim compensation for receiving the advertisements. Such a key feature combination is not disclosed or suggested by the '368 patent.

In view of these structural and procedural distinctions, present claims 1-20 patentably define over the '368 patent disclosure.

#### 14. U. S. Patent No. 6,026,369 to Capek

United States Patent No. 6,026,369 to Capek, hereinafter the '369 patent, discloses a method of distributing program material to a number of access providers. These access providers have identified themselves as having clients meeting profiles specified in a program material placement request, which is typically from an advertiser. Summary information is transmitted to a control distribution node from each of the access providers. The summary information describes customer profile information on the customers using each respective access provider. Such summary information is processed by the control distribution node to allocate the number of copies of program material available for delivery to the clients or customers by each of the access provider nodes.

There is no disclosure or suggestion in the '369 patent concerning the method called for by present claims 1-20. In contrast to the teaching of the '369 patent the method of applicant's claims 1-20 collectively comprises in combination a plurality of key features. Specifically, applicant's

claims 1-20 provide a method for advertising to a user accessing the Internet wherein a) an advertisement window opens and closes on the user's monitor within a preselected time frame, b) the user is not able to modify the advertisement window, and c) the user can claim compensation for receiving the advertisements. Collective use of the key features called for by applicant's claims 1-20 is not disclosed or suggested by the '369 patent teaching.

These structural and procedural distinctions provide ample basis upon which to predicate patentability of present claims 1-20 over the '369 patent disclosure.

15. U. S. Patent No. 6,036,601 to Heckel

United States Patent No. 6,036,601 to Heckel, hereinafter the '601 patent, discloses a method for advertising within the virtual environments of games. Default images of games are replaced by alternative textures having advertisements implemented therein. An ad server coordinates the matching of ads to demographic data of the game player and properly accommodates ads in formats from game information provided by game sources. The game player is visually influenced by advertisements as he or she views the virtual world of the game. Plug-in software replaces the default images with virtual pictures and figures utilizing an advertisement. View statistics are retrieved from the game player's computer or console to rate viewing effectiveness for ad placement confirmation and billing purposes.

There is no disclosure or suggestion in the '601 patent concerning the method called for by present claims 1-20. Unlike the teaching of the '601 patent, the method of applicant's claims 1-20 collectively comprises a plurality of key features. More specifically, applicant's claims 1-20 provide a method for advertising to a user accessing the Internet wherein a) an advertisement window opens and closes on the user's monitor within a preselected time frame, b) the user is not able to modify the advertisement window, and c) the user can claim compensation for receiving the advertisements.

When compared to the '601 patent teaching, the method called for by present claims 1-20 requires a unique combination of key features, as aforesaid, whereas the '601 patent does not.

These structural and procedural distinctions strongly ground patentability of applicant's claims 1-20 over the '601 patent disclosure.

16. [www.aol.com](http://www.aol.com)

The [www.aol.com](http://www.aol.com) web site contains a representative example of a pop-up window advertisement. The advertisement window is not displayed for a preselected time. It can be closed by the user. No compensation is received by the user for viewing the ad.

In view of these structural and procedural distinctions, present claims 1-20 patentably differentiate the [www.aol.com](http://www.aol.com) web site.

17. [www.webopedia.com](http://www.webopedia.com)

The [www.webopedia.com](http://www.webopedia.com) web site contains a representative example of a banner ad. An advertisement banner is an integral part of the web page. The ad may be different each time the web page is opened. It cannot be dismissed by the user. Unlike the method of present claims 1-20, compensation is not received by a user of the [www.webopedia.com](http://www.webopedia.com) web site for viewing the ad.

These structural and procedural distinctions clearly support patentability of present claims 1-20 over the [www.webopedia.com](http://www.webopedia.com) web site.

18. [www.entrpoint.com](http://www.entrpoint.com)

The [www.entrpoint.com](http://www.entrpoint.com) web site provides a free toolbar that resides on the user's monitor. Personalized news and other information are thereby delivered to the desktop. The user can dismiss the toolbar.

There is no disclosure or suggestion in the [www.entrpoint.com](http://www.entrpoint.com) web site concerning the method called for by present claims 1-20. Unlike the teaching of the [www.entrpoint.com](http://www.entrpoint.com) web site

the method of applicant's claims 1-20 comprises in combination a plurality of key features. More specifically, applicant's claims 1-20 provide a method for advertising to a user accessing the Internet wherein a) an advertisement window opens and closes on the user's monitor within a preselected time frame, b) the user is not able to modify the advertisement window, and c) the user can claim compensation for receiving the advertisements. Such a key feature combination is not disclosed or suggested by the [www.entrypoint.com](http://www.entrypoint.com) web site.

In light of these structural and procedural differences, there exists ample basis for patentably distinguishing present claims 1-20 from the [www.entrypoint.com](http://www.entrypoint.com) web site.

#### 19. Unicast Press Release

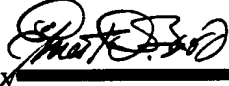
Superstitials are interactive, non-banner Internet commercials that can feature full animation, sound and graphics without slowing down the delivery of Web site content or the user's Web browsing experience -- regardless of a user's connection speed. The Unicast press release discloses a cache-and-play delivery system behind the Superstitial format. It minimizes the latency problems often experienced with streaming online advertising solutions.

Superstitial ads can be up to 100K in file size, hold any size and position on the screen and are created using the preferred authoring tools of the Internet industry -- including Macromedia Flash™. The superstitial ads are fully pre-loaded before playing and play only during a logical, user-initiated break in surfing, triggered by a mouse click. Such a process ensures that every user gets a consistent and complete ad message. Superstitial ads can be used to achieve multiple advertising goals, including branding, direct marketing, commerce and entertainment. Superstitial ad units are outside of the banner space. They create a distinctly different advertising tier for Web publishers and advertisers.

There is no disclosure or suggestion in the press release concerning the method called for by present claims 1-20. In contrast to the press release, the method of applicant's claims 1-20 comprises in combination a plurality of key features. Specifically, applicant's claims 1-20 provide a method for advertising to a user accessing the Internet wherein a) an advertisement window opens and closes on the user's monitor within a preselected time frame, b) the user is not able to modify the advertisement window, and c) the user can claim compensation for receiving the advertisements. There exists no disclosure or suggestion within the Unicast Press Release concerning the key feature combination called for by present claims 1-20.

In view of these structural and procedural differences, present claims 1-20 patentably define over the Unicast Press Release.

Respectfully submitted,  
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Attorney Docket No.: 0010-2

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of: Andrew S. Kanter  
Serial No.: 09/909,644  
Filed: July 20, 2001  
For: "INTERNET ADVERTISING"  
Docket No.: 0010-2

Group Art Unit: 2162  
Examiner: N/A

Morristown, N.J. 07960  
September 18, 2003

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

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**Ernest D. Buff**

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September 18, 2003

*(Date)*